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## TRANSMITTAL FORM

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Total Number of Pages in This Submission

7

Application Number 10/758,820

Filing Date 01/16/2004

First Named Inventor Joseph Lee Haughawout

Art Unit 2635

Examiner Name Yang, Clara I.

Attorney Docket Number 81230.68US3

### ENCLOSURES (Check all that apply)

<input type="checkbox"/> Fee Transmittal Form	<input type="checkbox"/> Drawing(s)	<input type="checkbox"/> After Allowance Communication to TC
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### SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm Name	Customer No. 34018 - Greenberg Traurig, LLP		
Signature			
Printed name	Gary R. Jarosik		
Date	January 18, 2006	Reg. No.	35,906

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Haughawout et al.	)	Examiner:	Yang, Clara I.
		)		
Serial No.:	10/758,820	)	Art Unit:	2635
		)		
Filed:	January 16, 2004	)	Attny Doc.:	81230.68US3
		)		
Title:	System And Method For	)		
	Using Appliance Power	)		
	Awareness to Select A	)		
	Remote Control Command	)		
	Set	)		

REPLY BRIEF

Mail Stop Appeal Briefs - Patents  
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Dear Sir:

Appellants hereby submit this Reply Brief to the Examiner's Answer of December 27, 2005.

This Reply Brief is being filed in triplicate.

The Commissioner is hereby authorized to charge any fee deficiency or credit overpayment to deposit account number 50-2428 in the name of Greenberg Traurig.

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By:

  
Vivian DelaRosa

## REMARKS

In the Examiner's Answer of December 27, 2005, the Examiner asserted that, despite the arguments set forth in the Appellant's Appeal Brief, the Examiner maintains the position that it would have been obvious to modify Kamon using the teachings of Ivie since, "one of ordinary skill in the art would recognize that a power monitor connected between an appliance and a power source, such as taught by Ivie, is preferable over Kamon's operation detection circuit (10) since a power monitor as taught by Ivie enables an appliance's headphone plug to be used as originally intended *and is able to accurately determine the appliance's power state even if the appliance is muted or lacks an audio output, which is a shortcoming of Kamon's operation detection circuit (10) due to its reliance on the presence of an audio output for determining an appliance's power state.*" (Examiner's Answer, pg. 10, emphasis added).

In response, it is respectfully submitted that, while the rational to modify or combine the prior art does not have to be expressly stated in the prior art but may be reasoned from knowledge generally available to one of ordinary skill in the art, established scientific principles, or legal precedent established by prior case law (*In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988)), a convincing line of reasoning still requires a demonstration that the knowledge generally available, established scientific principles, or legal precedent recognized that some advantage or expected beneficial result would have been produced by the combination of references. *In re Sernaker*, 702 F.2d 989 (Fed. Cir. 1983) (emphasis added). Since the Examiner has presented no evidence which can be said to objectively demonstrate that the knowledge generally available, established scientific principles, or legal precedent recognized that some advantage or expected beneficial result would have been produced by the combination of Kamon and Ivie, it is respectfully submitted that the rejection under 35 U.S.C. § 103 must be withdrawn.

More particularly, it is respectfully submitted that the Examiner has not set forth where either Kamon or Ivie demonstrates that one of ordinary skill in the art would have recognized that a power monitor connected between an appliance and a power source, such as taught by Ivie, is preferable over Kamon's operation detection circuit (10) for any reason, let alone for the reason that it would be advantageous to use a power monitor in lieu of the detection circuitry of Kamon which suffers problems due to its reliance on the presence of an audio output for determining an appliance's power state. This omission on the part of the Examiner is for the simple reason that neither reference does, in fact, expressly or impliedly suggest any motivation for, i.e., that any advantage would result by, modifying the system of Kamon. Thus, since both Kamon and Ivie are silent as to any advantages that would be achieved by modifying Kamon, the Examiner has been left to assert that the motivation to modify Kamon would be generally found in the supposed fact that one of ordinary skill in the art would have simply recognized that an advantage would result from modifying Kamon in the manner espoused, i.e., that it would have been "general knowledge" that a modification of Kamon in the manner espoused would allow for the accurate determination of the appliance's power state even if the appliance is muted or lacks an audio output, which is a shortcoming of Kamon's operation detection circuit (10). Of note, however, is the fact that this offered "evidence" as to what one of ordinary skill in the art would have simply recognized was not gleaned by the Examiner from any generally available knowledge but was, in fact, gleaned from the Appellants' response to the Examiner's initial rejection of the claims. (See Response of May 23, 2005, pg. 9). It is also to be noted that this "evidence" which allegedly demonstrates the obviousness of modifying Kamon has been raised for the first time within the Examiner's Answer which further demonstrates that the Examiner could not have found the motivation for modifying Kamon to thereby gain the espoused

advantages from the teachings of any references originally considered by the Examiner, i.e., references that arguably reflect the state of the knowledge generally available to one of ordinary skill in the art at the time of the invention.

In sum, based upon the facts that: a) no reference has been cited to evidence that one of ordinary skill in the art would have recognized that there would be advantages that would result from modifying Kamon in the manner espoused in the rejection of the claims (*See Dickinson v. Zurko*, 527 U.S. 150, 50 USPQ2d 1930 (1999) - general conclusions concerning what is “basic knowledge” or “common sense” to one of ordinary skill in the art without specific factual findings and some concrete evidence in the record to support these finding will not support an obviousness rejection); and b) that the most recently presented “evidence” in support of the conclusion of obviousness was not set forth, either expressly or impliedly, in any reference but was instead taken from arguments first advanced by the Appellants, the only conclusion that can be drawn is that the rejection of the claims under 35 U.S.C. § 103 is based upon the impermissible use of hindsight reasoning, i.e., the Appellants’ claims are being used as a template by the Examiner to find various elements in the cited references after which the Examiner is arriving at a motivation for combining the elements (with the most recent motivation being taken from the Appellants themselves) in an attempt to present a *prima facie* case of obviousness. For at least this reason it is respectfully submitted that the rejection under 35 U.S.C. § 103 must be withdrawn.

It is additionally respectfully submitted that the advantage originally offered by the Examiner to justify the proposed combination of Kamon and Ivie does not stand up to close scrutiny. More particularly, the Examiner did not originally explain why a person of ordinary skill in the art would have been motivated to extensively reconstruct the system of Kamon in

order to “enable an appliance’s headphone jack to be used as originally intended” when this objective is far more easily accomplished by simply using the system of Kamon in its unmodified state. In this regard, the unmodified system of Kamon already provides for a user to remove the operation detection from the headphone jack of the appliance after the remote control is setup to work with the appliance which, it will be appreciated, then leaves the headphone jack of the appliance free for its intended use. Furthermore, until the most recently submitted Examiner’s Answer it has not been explained why there would even be a need to ensure that the headphone jack remains free for its intended use during the short setup process disclosed within Kamon. Thus, since neither Kamon nor Ivie expresses any appreciation for the real advantages that would result from the invention set forth in the claims, it is submitted these facts additionally demonstrate that the suggestion for combining Kamon and Ivie in the manner advanced by the Examiner could only have been arrived at from hindsight knowledge impermissibly derived from the Appellants’ disclosure. For this yet further reason it is respectfully submitted that the rejection under 35 U.S.C. § 103 must be withdrawn.

It is still further respectfully submitted that the rejection of the claims additionally reflects the impermissible picking and choosing from a reference only so much of it as will support a given position to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art. *In re Hedges*, 783 F.2d 1038 (Fed. Cir. 1986). In this regard, it is respectfully submitted that the Examiner’s Answer further demonstrates that the Examiner has impermissibly relied upon the disclosure within Ivie of a current monitor to the exclusion of the other parts necessary to the full appreciation of how the system disclosed within Ivie operates in its entirety, especially as concerns the remote control. As discussed previously, when Ivie is considered in its entirety, *as is required*, the full teachings

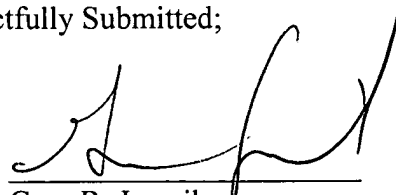
of Ivie would suggest that the headphone jack of Kamon's appliance may be rendered free not by modifying the power monitor of Kamon but instead by removing the Kamon power monitor from the headphone jack and modifying the remote control of Kamon whereupon the remote control of Kamon remains configurable by a user entering a number on the keypad to select which set of infrared codes from a library of infrared codes will apply. (See Ivie; col. 8, lines 34-52). Thus, it will be appreciated that modifying Kamon in the only manner that is in keeping with both the express teachings of Ivie and the espoused modification objective would not lead one of ordinary skill in the art to the invention claimed. For this still further reason it is respectfully submitted that a *prima facie* case of obviousness has not been presented and the rejection of the claims should be withdrawn.

It is respectfully submitted that the application is in good and proper form for allowance. Such action of the part of the Board is respectfully requested.

Respectfully Submitted;

Date: January 18, 2006

By:



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